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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,311

07/20/2006

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EXAMINER

HOOK, JAMES F

ART UNIT

PAPER NUMBER

3754

NOTIFICATION DATE

DELIVERY MODE

09/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
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USPTO@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,311	<b>Applicant(s)</b> MOHRI ET AL.	
	<b>Examiner</b> James F. Hook	<b>Art Unit</b> 3754	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7, 8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bittner. The reference to Bittner discloses the recited flexible pipe comprising a first resin layer 9, a conductive metal layer 6,7, a second resin layer 11 in this order from below on an outer surface of a corrugated metal pipe 5 for flowing a fluid, wherein the resin layer covers the entire outer surface of the corrugated metal pipe, the conductive layer is constituted by at least one metal tape extending along the corrugated metal pipe, the resin layer is an insulating layer, the first and second resin layers are insulating layers, and the metal layer is constituted by at least one metal tape layer formed as flat wires or strips.

Claims 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bittner. The reference to Bittner

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discloses the recited structure above, including a parting layer 10 between the first and second insulating resin layers. The reference to Bittner discloses all of the recited structure with the exception of forming the first and second insulating layers as easily peelable layers, however, since there is no actual structure claimed which is different than that set forth in Bittner it is considered that such would be an inherent property of the plastic in that there is no degree of how peelable the layers need to be and that the plastic layers are inherently capable of being peeled. However, should such be considered an actual limitation that is not inherent to the plastic layers of Bittner then it would have been obvious to one skilled in the art to modify the plastic layers in Bittner to be easily peeled should such require peeling to allow for connection to connectors for connecting the hose to a source of fluid as such would only require routine experimentation to arrive at optimum values for the plastics used as such is merely a choice of mechanical expedients.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7, 8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iyengar in view of Bittner. The reference to Iyengar discloses the recited flexible pipe comprising a first resin layer 30, a conductive metal layer 36, a

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second resin layer 22 in this order from below on an outer surface of a corrugated metal pipe 32, wherein the metal layer is constituted by at least one metal tape longitudinally extending along the corrugated metal pipe, the first and second resin layers are insulating layers, the metal layer is a metal plating, the plastic layers can inherently be removed by peeling, and with no specific amount of peeling strength being claimed, such would meet the claim language of claim 11, the layers are laminated and a parting layer 26 is provided between layers to separate or part them. The reference to Iyengar discloses all of the recited structure with the exception of using the pipe for flowing of fluid, however such could be considered intended use. The reference to Bittner discloses that it is old and known that corrugated tubing of the structure similar to that of Iyengar can not only be used to encase wires but can also be used for fluids as well, thereby teaching that a pipe such as Iyengar is capable of use for fluids as well. It would have been obvious to one skilled in the art to utilize the pipe of Iyengar for flowing fluids as suggested by Bittner where such is a known intended use for corrugated pipes of this structure where such can also be used as wire covers, and that the pipes of these structures are capable of use with fluids.

### ***Response to Arguments***

Applicant's arguments filed June 17, 2010 have been fully considered but they are not persuasive. Most of the arguments are moot due to the fact that the rejections have been dropped. With respect the arguments directed at Bittner, element 6 is described as being "strips" in column 3, lines 7-16, and a strip is a tape, where

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disposing such in a spiral manner with a low winding angle such as Bittner along the length of the pipe would in fact have a longitudinal extent in that the strips 6 are disposed along the longitudinal extent of the pipe regardless of whether they do so in a helical fashion, such would still meet the claim language. With respect to the argument that the hose of applicant's claims are for easy recycling, such is not being claimed but would also be merely intended use and/or method steps in an article claim which would not provide any structural limitations that would hold much patentable weight. The layers of Bittner that are plastic are in fact formed of thin foil layers which inherently would be capable of peeling to some extent and as set forth above, without a specific amount of peeling strength, other than the non specific term "easily" the layers would meet the ability to be peeled. With respect to the argument that laminated plastics would be difficult to peel, such is not supported by any proof or evidence, and further it is noted that applicant is claiming a laminated plastic layer as well, so one would expect a similar peeling ability with a pipe teaching the same structure. It is immaterial what pressure the hose of Bittner is intended to carry or that the strips are tensioned, the structure of these elements still meets the claim language especially when the claim language allows for more than one strip to exist, and further using the term "comprising" permits the prior art to teach additional structure and still meet the claim language. As set forth above, the strips of Bittner have a longitudinal extent in that they extend along the longitudinal axis of the pipe.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Bow and Jager disclosing state of the art tubular articles.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/  
Primary Examiner, Art Unit 3754

JFH